

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JING GUI, BRUNO J. MARCHON,  
DALLAS W. MEYER and PETER SEGAR

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Appeal No. 2000-1101  
Application No. 08/702,325

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ON BRIEF

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 5 to 17, 19, 29 and 30. Claims 24 to 28 have been allowed. Claims 4, 18 and 20 to 23 have been canceled.

We REVERSE.

### BACKGROUND

The appellants' invention relates to magnetic discs used in computer disc drives, and, more particularly, to the use of texturing of a thin film magnetic disc surface and to processing of lubricant used on the thin film magnetic disc for reduced stiction associated with stop times of the disc drive (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ohnuki et al. (Ohnuki)	5,292,585	March 8, 1994
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Gonnella et al. (Gonnella)	5,593,341	Jan. 14, 1997
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Encyclopedia of Polymer Science and Engineering; Volume 16; pp. 379-381; 1992  
(Polymer Science Encyclopedia)

Claims 1 to 3, 5 to 17, 19, 29 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gonnella in view of Ohnuki and the Polymer Science Encyclopedia.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 17, mailed August 5, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 16, filed April 19, 1999) and reply brief (Paper No. 18, filed October 8, 1999) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 3, 5 to 17, 19, 29 and 30 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to

combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

All the claims under appeal require in one manner or another a lubricant over both the landing zone and the data zone of a thin film magnetic disc wherein the lubricant has been fractionated to exclude fractions of high molecular weight relative to molecular weights of the lubricant prior to fractionation.

In the rejection before us in this appeal, the examiner (1) set forth teachings of the applied prior art (answer, pp. 3-4); and (2) determined that it would have been obvious to one of ordinary skill in the art to (a) use a purified lubricant as taught by Ohnuki on Gonnella's magnetic disc, and (b) use carbon dioxide to purify Ohnuki's lubricant as suggested by the Polymer Science Encyclopedia (answer, pp. 4-5).<sup>1</sup>

Based on our analysis and review of Gonnella and the claims under appeal, it is our opinion that one difference is the limitation that the lubricant over both the landing zone and the data zone of the thin film magnetic disc has been fractionated to exclude

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<sup>1</sup> The examiner did not ascertain the differences between the prior art and the claims at issue or determine that the claimed subject matter would have been obvious at the time the invention was made to a person of ordinary skill in the art.

fractions of high molecular weight relative to molecular weights of the lubricant prior to fractionation. However, this limitation is not suggested by the applied prior art. Ohnuki teaches to use a purified lubricant by excluding fractions of **low** molecular weight.<sup>2</sup>

Ohnuki does not teach or suggest using a purified lubricant by excluding fractions of **high** molecular weight.<sup>3</sup> To supply this omission in the teachings of the applied prior art, the examiner made a determination (answer, pp. 5-7) that there is a likelihood that in Ohnuki's process of purifying a lubricant by excluding fractions of **low** molecular weight that high molecular weight fractions would also be eliminated. However, this determination has not been supported by any evidence.<sup>4</sup>

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<sup>2</sup> See, for example, column 3, line 63, to column 4, line 21; column 4, lines 59-63; column 5, lines 17-20; column 7, lines 35-40; table 1; and claim 1.

<sup>3</sup> See pages 3-10 of the brief and pages 1-4 of the reply brief.

<sup>4</sup> The examiner's broad conclusory statement, standing alone, is not "evidence." See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). When relying upon a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In this case, the examiner has not shown that the natural result flowing from the method of purifying a  
(continued...)

Since the claimed subject matter is not suggested by the applied prior art for the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 5 to 17, 19, 29 and 30 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 to 17, 19, 29 and 30 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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<sup>4</sup>(...continued)  
lubricant by excluding fractions of low molecular weight as taught by Ohnuki necessarily results in also excluding fractions of high molecular weight.

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